

REMARKS

Applicant has canceled claims 2, 37-40, 42 and 43; and amended independent claims 1 and 41, and claim 20. Applicant acknowledges the Examiner's indication that claims 34 and 36 are allowable. Claims 1, 3-36, 41, and 44-59 are presented for examination.

*Election/Restrictions*

Applicant affirm the election of the species directed to platinum, without traverse.

However, since it appears that the election only affects claims 27-36, and that the Office Action has indicated that claim 34 (directed to platinum) is allowable, Applicant requests that generic claim 27 be substantively examined. Upon indication that claim 27 is allowable, Applicant submits that claims 28-36 would also be allowable.

*Claim Objections*

Claims 14-17, 33, 37, and 52-55 are objected to because it is unclear where the martensitic phase is from. But as one skilled in the art would recognize, the term "martensitic" is not unique to iron-based materials. Rather, "martensite" refers to "a generic term for microstructures formed by diffusionless phase transformation in which the parent and product phases have a specific crystallographic relationship. Martensite is characterized by an acicular pattern in the microstructure in both ferrous and nonferrous alloys." (See Metals Handbook Desk Edition, H.E. Boyer, T.L. Gall, American Society for Metals, 1985, ISBN 0-87170-188-X, p.1.25, emphasis added.) Accordingly, Applicant requests that the objection be withdrawn.

Claim 20 has been amended to address typographical errors.

*Claim Rejection – 35 U.S.C. § 102*

Claims 1, 4-7, 13-23, 37-41, 44-47, 49-54, and 56-59 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,666,930 (Aoyama). The pending independent claims are 1 and 41. Claims 1 and 41 have been amended to include, respectively, the features of claims

2 and 42, neither of which were rejected over Aoyama. Accordingly, the rejection should be withdrawn.

Claims 1, 4-8, 13-23, 37-41, 44-47, 50-54, and 56-59 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,929,420 (Cook). The pending independent claims are 1 and 41. Claims 1 and 41 have been amended to include, respectively, the features of claims 2 and 42, neither of which were rejected over Cook. Accordingly, the rejection should be withdrawn.

Claims 1, 3, 4-9, 13-21, 37-41, 43-47, and 50-59 are rejected under 35 U.S.C. § 102(b) as anticipated by JP 57-043948A (JP '948). The pending independent claims are 1 and 41. Claims 1 and 41 have been amended to include, respectively, the features of claims 2 and 42, neither of which were rejected over JP '948. Accordingly, the rejection should be withdrawn.

Claims 1, 2, 4-9, 13-21, 37-42, 44-47, and 50-59 are rejected under 35 U.S.C. § 102(b) as anticipated by JP 61-133339A (JP '339). The pending independent claims are 1 and 41.

As amended, claim 1 positively recites in its body that the alloy forms a portion of the medical device, thereby clearly indicating that the claim 1 and its dependent claims are directed to medical devices. As acknowledged in the Office Action, JP '339 is directed to ornaments, such as rings, necklaces, and brooches. JP '339 does not disclose or suggest using an alloy to form a portion of the medical device, and therefore, the rejection should be withdrawn.

Claim 41 has been amended to include the features of claim 43, which was not rejected as anticipated by JP '339. Accordingly, this rejection should be withdrawn.

Claims 10-12, 48, and 49 are rejected under 35 U.S.C. § 102(b) or (e) as anticipated by JP '339, JP '948, Cook, or Aoyama. Claims 10-12, 48, and 49 depend from claim 1 or 41, and thus are patentable over the cited references for at least the same reasons discussed above that claim 1 or 41 is patentable.

#### ***Claim Rejections – 35 U.S.C. § 103***

Claims 22-26, which depend from claim 1, are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '948 or JP '339 or Cook or Aoyama in view of U.S. Patent No. 5,524,338

(Martyniuk). In particular, the Action has acknowledged that JP '948, JP '339, Cook and Aoyama do not teach a medical device and has relied on Martyniuk for teaching a medical device.

As indicated above, claim 1 (from which claims 22-26 depend) has been amended to include the features of now-canceled claim 2 (that the alloy comprises about 3 to about 22 weight percent of chromium). The Action apparently has acknowledged that Aoyama, Cook, and JP '948 do not disclose or suggest this range of chromium. Thus, even if Aoyama, Cook, or JP '948 could be combined with Martyniuk, which Applicant does not concede, the combination would not result in the claimed medical device. Applicant requests that the rejection be reconsidered and withdrawn.

With regard to the rejection based on JP '339 and Martyniuk, Applicant submits that there is no motivation to combine these references. The sole motivation provided by the Action is that since Martyniuk discloses a medical device of one platinum alloy (here, Pt-Ir), then it would have been obvious to substitute the alloy and make a medical device of any platinum-containing alloy. Clearly, without more guidance from Martyniuk, the Action is applying an obvious-to-try standard, which of course is not permissible. See, e.g., In re Fine, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

Furthermore, assuming while not conceding that somehow Martyniuk suggests using other platinum-containing alloys for a medical device, there is no suggestion to use an alloy having greater than about 50 weight percent of platinum, as claimed. That is, Martyniuk discloses only a Pt-Ir alloy, but there is no indication that this alloy should contain high amounts or low amounts of platinum. The assertion in the Action that it would have been obvious to use a high platinum content alloy is not supported by Martyniuk. The rejection is either improperly based on an obvious-to-try standard or improperly applying hindsight analysis using Applicant's claims as a template. Applicant submits that the claims are patentable over JP '339 and Martyniuk.

Applicant believes the claims are in condition for allowance, which action is requested.

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Respectfully submitted,

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